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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/757,070

01/08/2001

E. Weston Scaman

FIS9-2000-0229US1

6594

7590

07/10/2006

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## DETAILED ACTION

### *Response to Amendment*

1. The amendment to the claims filed on 2/17/2006 does not comply with the requirements of 37 CFR 1.121(c) because the claims submitted 2/17/2006 must include a listing of ALL claims presented to date. The amendment history of this case is extensive, but examiner notes that all claim amendments have been entered as a matter of right, since there has not been a final rejection, Quayle action, or allowance. Since the amendments, even if non-compliant or non-responsive, have been entered, each and every subsequent amendment must account for every claim in the case.

DATE	Claims Pending	Claims Cancelled
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1/08/2001	1-52	
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6/22/2005	53-83	1-52
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non-responsive - claims 53-83 directed to non-elected species- withdrawn by examiner

9/12/2005	53-100	1-52
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Problem - as of 6/22/05, claims 1-52 are cancelled, claims 53-83 are pending. Thus amendment of 9/12/2005 must account for all claims 1-83. However, it listed as cancelled only 1-52, and listed 53-100 as new - this is incorrect - there are already claims 53-83 (withdrawn by examiner but still pending) in the case

due to 6/22/05 amendment. Called applicant as courtesy on or about 10/20-24/2005 to alert that a new non-compliant was being mailed because of duplicate claims 53-83.

10/25/2006            84-131            1-83

Same problem - now claims 84-100 have duplicates - the amendment of 9/12/2005, while non-compliant, is still entered as a matter of right. Thus the amendment of 10/25/05 must account for claims 1-100 before entering any new claims.

As of the last amendment, claims 1-83 are cancelled and new claims 84-131 are pending, and there is no account of original claims 84-100 which are also still pending from the 9/12/2005 amendment. Thus since 84-100 entered 9/12/2005 are pending, it is not possible to have new claims 84-131.

Any amendment now MUST list claims 1-131 in some manner before adding any new claims. Examiner is only supposed to give one inadvertent non-compliance, but is giving this 3<sup>rd</sup> notice since applicant is clearly attempting to comply, and there was a delay due to USPTO electronically misfiling the 2/2006 amendment that would result in automatic abandonment of the application, which seems unduly harsh to examiner. However, any further non-compliance will be held to be deliberate and the case will be abandoned.

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Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR

1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

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(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

2. Since the reply filed on 2/17/2006 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine W Mitchell  
Primary Examiner  
Art Unit 3677

A handwritten signature in black ink, appearing to read 'Katherine W Mitchell', written in a cursive style.

Kwm  
7/7/2006